

**REMARKS**

Claims 1-27 are outstanding. No claims have been canceled or added. Claims 1-22 have been withdrawn. Claim 23 has been amended. Reconsideration and allowance of all the claims are respectfully requested.

Applicant has carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested. No new matter has been added by any of the amendments to the specification. Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

**CLAIM REJECTIONS – 35 U.S.C. §103(a)****Claims 23, 25 and 27**

The Examiner rejected claims 23, 25 and 27 under 35 U.S.C. §103(a), as being unpatentable over Avery (U.S. Patent No. 2,391,539) in view of Kon et al (Japanese Patent No. 62-62736). The Examiner has stated that:

Regarding claim 23, Avery discloses a method of forming labels. The method includes providing a roll of paper stocks, drawing the paper stocks and laminating the paper stocks to adhesive coated backing. (Page 1, Col 2, lines 31-48). The paper stock is also divided by cutting blades into separates strips that remain in contiguous edge-to-edge relationship as the strips are pressed with the laminating rolls into firm engagement with the adhesive on the backing (Page 2, Col 1, lines 36-50) and the strips can be removed from the backing and applied to any desired article (Page 2, Col 1, lines 62-65) and the laminated is capable of being use as a packaging material, which satisfying the requirement of intended use as a packaging film. Avery does not disclose the distance from slitting step to form a strip occurs within 1-24 inches from the pressing step. However, Kon et al discloses a method of forming laminated film, which provide a slitting step or slit wheel just before lamination, (See English Abstract of JP 62-62736) and furthermore, determination of the specific distance between the slitting and pressing steps would have been well within the realm of routine experimentation to one of ordinary skill in the art at the time of the invention in view of the

teaching of Kon et al that recognizes that the location, i.e. just before lamination, of the slitting step is ripe for optimization.

**Response:**

Applicants thank the Examiner for the opportunity to better explain why the present invention is patentable in light of the prior art. Claim 23 has been amended to better define the intended scope of the invention. Specifically, claim 23 was amended to add the limitation that the first flexible film comprise a graphics layer and the second flexible film comprise a barrier layer. Support for this amendment can be found in paragraph 28 of the published patent application (Publication No. 2005/0079322). In light of this amendment, applicants respectfully request that the Examiner withdraw the rejection as to claims 23, 25 and 27.

**Claim 25**

The Examiner rejected claim 25. The Examiner has stated that:

...Avery discloses pressing the paper stocks to the adhesive coated backing (Page 2, Col 1, lines 18-35), which would apply the adhesive to the paper stocks.

**Response:**

All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Claim 25 has the required limitation of “applying an adhesive layer to said first flexible film.” The first flexible film is the film layer that is slitted longitudinally in the claimed invention. The second flexible film is not slit or cut.

Avery, unlike the present invention teaches the step of applying an adhesive to the substrate that is not cut, e.g., the second layer. For example, a careful reading of the area cited by the Examiner reveals that Avery actually teaches away from applying an adhesive to the first or cut flexible film layer because Avery discloses that, “the adhesive tends to be picked up by the

cutting blades with the result that the blades must be regularly and periodically cleaned unless cutting of the paper can be accomplished along stripes or areas to which no adhesive has been applied.” In fact, Avery teaches adding the adhesive to the backing, as clearly outlined in the Avery reference which states, “A feature of the invention resides in the fact that the paper 10 is longitudinally divided prior to its being brought into adhesive engagement with the backing 15 that has the coating of the adhesive thereon.” (Avery, page 2, column 1, lines 18-22).

Consequently, because Avery fails to disclose, teach or suggest the limitation of “applying an adhesive layer to said first flexible film,” applicants respectfully request that the Examiner withdraw the rejection as to claim 25.

#### **Claim 27**

The Examiner rejected claim 27. The Examiner has stated that:

...Avery discloses the backing is glassine, which includes a release coating.  
(Page 2, Col 1, lines 4-9).

#### **Response:**

A proper *prima facie* case of obviousness requires that the prior art reveal a reasonable expectation of success carrying out the proposed combination or modification. *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *Id.*

The present invention is directed towards a flexible film that can be easily shaped so it can be used in a vertical form fill and seal machine to package low-moisture, shelf-stable food product. One object of the Avery reference, on the other hand, is “to provide a backing sheet on which separated tapes or labels are mounted . . . whereby the backing sheet may serve as a convenient holder for holding the tapes or labels . . . .” (Avery, p. 1, col. 1, lns. 4-9). Glassine is used in the backing sheet and “[i]n this form it is virtually essential that a hard, unyielding

backing be employed of the character of glassine.” (Avery, p. 2, col. 2, lns. 29-31). “By using an incompressible hard backing, such as glassine such snapping through does not take place with the result that the paper only is divided upon the transverse lines and the backing remains entirely intact, such as is illustrated in Fig. 5.” (Avery, p. 2, col. 2, lns. 43-48). Its difficult for applicants to understand how a “hard, unyielding” material could be reasonably combined with a flexible film that would be used on a vertical form, fill and seal machine. Because an incompressible hard backing such as glassine is not compatible with the flexible film of the claimed invention, applicants respectfully request the Examiner withdraw the rejection as to claim 27.

#### **Claim 24**

The Examiner rejected claim 24 under 35 U.S.C. §103(a), as being unpatentable over Avery (U.S. Patent No. 2,391,539) in view of Kon et al (Japanese Patent No. 62-62736) as applied to claim 23 above, and further in view of Holmstrom et al (U.S. Patent No. 4,256,791).

The Examiner has stated that:

Avery as modified above is silent as to extruding a molten plastic layer between the layers. However, extruding a molten plastic layer between layers as adhesive is well known and conventional as shown for example by Holmstrom et al. Holmstrom et al discloses a method of laminating a material. The method includes extruding a plastic layer, i.e. adhesive layer, between the webs or layers prior to laminating with pressure rollers. (Col 4, lines 15-32).

#### **Response:**

In determining whether particular references might be properly combined, whether it is obvious to try a combination is not a legitimate test. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). The test is whether the combination of the references or modification would be obvious to **do** rather than obvious to **try**. *In re Deuel*, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210, 1216 (Fed. Cir. 1995). A general incentive does not make obvious a

particular result, nor does the mere existence of techniques which may be carried out to achieve the particular result. *Id.* The mere fact that the prior art could be readily modified to arrive at the claimed invention does not render the claimed invention obvious; the prior art must suggest the desirability of such a modification. *In re Ochiai*, 71 F.3d 1565, 1570, 37 U.S.P.Q.2d 1127, 1131 (Fed. Cir. 1996); *In re Gordon*, 733 F.2d 900, 903, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Merely stating that the modification would have been obvious to one of ordinary skill without identifying an incentive or motivation for making the proposed modification is insufficient to establish a *prima facie* case. Consequently, applicants respectfully request that the Examiner withdraw the rejection as to claim 24.

#### **Claim 26**

The Examiner rejected claim 26 under 35 U.S.C. §103(a), as being unpatentable over Avery (U.S. Patent No. 2,391,539) in view of Kon et al (Japanese Patent No. 62-62736) as applied to claim 23 above, and further in view of Wallace (GB 1,399,922). The Examiner has stated that:

Avery as modified above is silent as to a release coating is applied to the label or paper stocks. However, applying a release coating to the label [is] well known and conventional as shown for example by Wallace. Wallace discloses a method of forming labels. The method includes applying a release coating to the strip of fabric labels prior to laminating with adhesive coated backing. (Page 1, line 84 to Page 2, line 14).

#### **Response:**

The claimed invention, in claim 26, is directed towards a flexible film, having a strip with release coating, that can be easily shaped so it can be used in a vertical form fill and seal machine to package low-moisture, shelf-stable food product. As fully discussed in paragraph 35 of the published patent application, because the strip is coated with a release coating, the adhesive does not peel off with the strip, but remains with the underlying barrier web so that the adhesive is

visible on the bag and permits the user to roll or fold the upper edge of the package over and use the adhesive on the bag to hold the top closed. Such configuration offers an inexpensive alternative to the use of more expensive zipper closures.

Avery is directed towards making pressure sensitive adhesive labels, e.g. mailing labels. Kon is directed towards a method for removing air trapped in a cover of film. Wallace is directed towards fabric labels that can be sewn onto garments.

To support the conclusion that the claimed invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex Parte Clapp*, 227 U.S.P.Q. (BNA) 972, 973 (Bd. Pat. App. & Int. 1985); M.P.E.P. 706.02(j). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. See *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). The Examiner's failure to provide the necessary suggestion or motivation for the combination of Avery, Wallace, and Kon creates a presumption that the combination was selected by Examiner to support the obviousness rejection based on improper hindsight. A determination of the desirability of combining prior art references must be made without the benefit of hindsight afforded by the Applicant's disclosure. *In re Paulsen*, 30 F.3d 1475, 1482, 31 U.S.P.Q. 1671, 1676 (Fed. Cir. 1994). Thus, even if the Avery, Wallace, and Kon references could be combined in the manner suggested by the Examiner, the modification or combination is not obvious, because neither reference suggest or teach the desirability of the modification. Thus, the claimed invention may only be reached using the presently claimed invention as a template to piece together and modify the teachings of Avery,

Wallace, and Kon to teach the presently claimed invention. Such reliance is an impermissible use of hindsight with the benefit of Applicant's disclosure. Thus, it is respectfully submitted that Examiner has not established a prima facie case of obviousness and the rejection of claim 26 should be withdrawn.

### **CONCLUSION**

Applicant has adopted the Examiner's suggestions and believes the claims are in condition for allowance. It is respectfully urged that the subject application is patentable over references cited by Examiner and is now in condition for allowance. Applicant requests consideration of the application and allowance of the claims. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Chad E. Walter at 972.367.2001.

The Commissioner is hereby authorized to charge any additional payments that may be due for additional claims to Deposit Account 50-0392.

Respectfully submitted,

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